

REMARKS**Claim Amendments**

In an effort to move this case forward, Applicants presently amend claims 1, 9, and 17 in this Response and cancel claims 2, 10, and 18. Independent claim 1 now includes limitations previously recited in claim 2, now cancelled. Independent claim 9 now includes limitations previously recited in claim 10, now cancelled. Independent claim 17 now includes limitations previously recited in claim 18, now cancelled. Although Applicants have amended claims 1, 9, and 17 to include additional limitations, Applicants do not concede that claims 1, 9, and 17 as originally filed are not patentable over the art cited by the Office Action. In fact, Applicants reserve the right to pursue these originally filed claims in one or more continuation applications. Applicants submit that these amendments do not introduce any new matter and submit that the claims as currently amended are in condition for allowance.

Claim Rejections – 35 U.S.C. § 112 Second Paragraph

Claims 17-24 stand rejected under 35 U.S.C. § 112, second paragraph for lack of antecedent basis. The Office Action takes the position that “the recording medium” recited in claims 17-24 lacks antecedent basis. In response, Applicants have amended claims 17 to recite “a recording medium.” Applicants respectfully submit that this amendment adds no new matter to the specification. Applicants further submit that claims 17-24 are therefore patentable and request reconsideration of claims 17-24.

Claim Rejections - 35 U.S.C. § 101

Claims 9-24 stand rejected under 35 U.S.C. § 101 on grounds that the claims recite non-statutory subject matter. The Office Action at page 2, states:

With respect to claim 9, “A system for establishing trust in an email client” is being recited. A system for establishing trust in an email client comprises of components that are software. A software is not one of the statutory subject matter. See MPEP § 2106.01.

With respect to claims 17-24, “computer program product” is being recited. A computer program product is comprises components that are software. A software is not one of the statutory subject matter. See MPEP § 2106.01.

Applicants understand this statement from the Office Action as an assertion that the system and computer program product for establishing trust in an email client recited in Applicants’ claims 9-16 and 17-24 somehow claims components that are software, and that software is not statutory subject matter under 35 U.S.C. § 101. Applicants respectfully submit in response, however, that MPEP 2106.01 states:

....a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. [emphasis added]

That is, a computer-readable medium encoded with a computer program is statutory. Applicants’ claims 17-24 and the original specification at page 5, recite a computer program product that is encoded on a recording medium. Any software corresponding to the system of claims 9-16 or the computer program product of claims 17-24 is computer readable. Any software corresponding to the system of claims 9-16 or the computer program product of claims 17-24 is disposed in a recording medium. The recording medium as recited in claims 17-24 and described in the specification is therefore computer readable. Because the recording medium is computer readable, any software corresponding to the system of claims 9-16 or the computer program product of claims 17-24, disposed within such medium, is statutory subject matter. The rejection under 35 U.S.C. § 101 is therefore improper and should be withdrawn. For the reasons set forth above, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 101 and reconsideration of claims 9-24.

Claim Rejections – 35 U.S.C. § 102 Over Weatherby

Claims 1, 2, 4-10, 12-18, and 20-24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Weatherby (U.S. Publication No. 2004/0054741 A1). To anticipate claims 1, 2, 4-10, 12-18, and 20-24 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Weatherby must disclose each and every element and limitation as set forth in the Applicants' claims. The second requirement of anticipation is that Weatherby must enable Applicants' claims. Weatherby does not meet either requirement and therefore does not anticipate Applicants' claims.

Weatherby Does Not Disclose Each And Every Element Of The Claims Of The Present Application

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As amended, independent claim 1 of the present application recites:

1. A method for establishing trust in an email client, the method comprising:
 - accepting in an email server a data communications connection from an email client, wherein the connection includes the email client's network address;
 - determining from a stored list of trusted network addresses whether the email client is trusted according to the email client's network address;
 - if the email client is not trusted according to the email client's network address, receiving authentication data from the email client and determining whether the email client is trusted according to the authentication data; and

if the email client is not trusted according to the email client's network address and the email client is not trusted according to the authentication data, receiving a sender domain name for an email message from the email client and determining whether the email client is trusted according to the sender domain name, wherein determining whether the email client is trusted according to the sender domain name further comprises requesting from a domain name service a resource record of a type that lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain.

As explained in more detail below, Weatherby does not disclose each and every element of claim 1, and Weatherby therefore cannot be said to anticipate claim 1 of the present application within the meaning of 35 U.S.C. § 102(e).

**Weatherby Does Not Disclose Requesting From A Domain Name
Service A Resource Record Of A Type That Lists For A Sender
Domain Network Addresses Of Email Exchanges That Are Authorized
To Act As Outbound Email Exchanges For The Sender Domain**

The Office Action takes the position that Weatherby at paragraph 0030, lines 1-7, and paragraph 0041, lines 1-18, discloses the following portion of the fourth element of claim 1, as amended in this Response: wherein determining whether the email client is trusted according to the sender domain name further comprises requesting from a domain name service a resource record of a type that lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain. Applicants respectfully note in response, however, that what Weatherby at paragraph 0030, lines 1-7, discloses is:

[0030] When an incoming message is received by a preferred embodiment of the present invention, the sender's E-mail address is preferably compared against a system-wide list of E-mail addresses which are to be blocked (Block 105). Such a list may include individual E-mail addresses, such as tom@blah.com, or E-mail addresses from entire domains, such as *@blah.com.

In addition, what Weatherby at paragraph 0041, lines 1-18, in fact discloses is:

[0041] While it is true that a UCE distributor could potentially produce a robot that will automatically click on any links returned within an email, to do so, the UCE distributor must use one or more non-spoofed email accounts, must receive all challenge handshake messages, and must engage in a three-way process that corroborates illegal actions. While it is difficult to stop someone intent on fooling any system, the present invention can also employ additional techniques to thwart robots. Furthermore, the verification techniques employed by the present invention require UCE distributors to give up their anonymity because the sender's IP address, domain name, and HTTP IP address are all preferably logged and reported when the sender validates with the present invention. An additional benefit of the present invention is its ability to automatically add all sender E-mail addresses whose challenge message bounces due to unknown user or other SMTP errors to the recipients' blocked list.

That is, Weatherby at paragraph 0030, lines 1-7 and paragraph 0041, lines 1-18, discloses comparing the sender's E-mail address against a system-wide list of E-mail addresses which are to be blocked. Weatherby's comparison of the sender's E-mail address against a system-wide list of E-mail addresses which are to be blocked does not disclose requesting from a domain name service a resource record of a type that lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain, as claimed in the present application.

Weatherby's system-wide list of E-mail addresses which are to be blocked is not a resource record, as claimed in the present application. A resource record, as claimed in the present application, is requested from a domain name service, and lists for a sender domain network, addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain. In contrast, Weatherby's system-wide list of E-mail addresses is located on the email client's system - not requested from a domain name service, and lists blocked email addresses – not addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain. In fact, at no point in the reference does Weatherby even mention “a resource record”, “domain name service”, or an “email exchange.” Without disclosing requesting from a domain name service a resource record of a type that lists for a sender domain network addresses of

email exchanges that are authorized to act as outbound email exchanges for the sender domain, as claimed in the present application, Weatherby does not disclose the fourth element of claim 1. Because Weatherby does not disclose each and every element and limitation of Applicants' claims, Weatherby does not anticipate Applicants' claims, and the rejections under 35 U.S.C. § 102(e) should be withdrawn.

**Weatherby Does Not Enable Each And Every Element
Of The Claims Of The Present Application**

Not only must Weatherby disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Weatherby must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the Applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Weatherby places Applicants' claims in the possession of a person of ordinary skill in the art, Weatherby is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102(b). As explained above, Weatherby does not disclose each and every element and limitation of independent claim 1 of the present application. Because Weatherby does not disclose each and every element and limitation of the independent claims, Weatherby cannot possibly place the elements and limitations of independent claim 1 in the possession of a person of ordinary skill in the art. Weatherby cannot, therefore, anticipate claim 1 of the present application.

Relations Among Claims

Independent claims 9 and 17 are system and computer program product claims, respectively, for establishing trust in an email client corresponding to independent method claim 1. Claim 1 is allowable for the reasons set forth above. Claims 9 and 17 are allowable for the same reasons that claim 1 is allowable. The rejections of claims 9 and 17 therefore should be withdrawn, and claims 9 and 17 should be allowed.

Claims 2-8, 10-16, and 18-24 depend respectively from independent claims 1, 9, and 17. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Weatherby does not disclose or enable each and every element of the independent claims, Weatherby does not disclose or enable each and every element of the dependent claims of the present application. As such, the rejections of claims 2-8, 10-16, and 18-24 should also be withdrawn, and the claims should be allowed.

Claim Rejections – 35 U.S.C. § 103 Over Weatherby In View of Lalonde

Claims 3, 11, and 19 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Weatherby, in view of Lalonde (U.S. Publication No. 2004/0068542 A1). The question of whether Applicants claims are obvious *vel non* is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of other. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a *prima facie* case of obviousness to reject Applicants claims for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

To establish a *prima facie* case of obviousness, the proposed modification of Weatherby in view of Lalonde must teach or suggest all of the claim limitations of dependent claims

3, 11, and 19. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Dependent claims 3, 11, and 19 depend from independent claims 1, 9, and 17 and include all the limitations of the independent claims from which they depend. In rejecting dependent claims 3, 11, and 19, the Office Action relies on Weatherby as disclosing each and every element of independent claims 1, 9, and 17. Because neither Weatherby nor Lalonde disclose each and every element of independent claims 1, 9, and 17, the Office Action's proposed modification of Weatherby in view of Lalonde cannot possibly disclose each and every element of dependent claims 3, 11, and 19. The proposed combination of Weatherby and Lalonde, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

Conclusion

Claims 1, 2, 4-10, 12-18, and 20-24 stand rejected under 35 U.S.C. § 102 as being anticipated by Weatherby. For the reasons set forth above, Weatherby does not disclose each and every element of Applicants' claims and does not enable Applicants' claims. Weatherby therefore does not anticipate Applicants' claims. Claims 1, 2, 4-10, 12-18, and 20-24 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually, and request reconsideration of claims 1, 2, 4-10, 12-18, and 20-24.

Claims 3, 11, and 19 stand rejected for obviousness under 35 U.S.C. § 103 as being unpatentable over Weatherby in view of Lalonde. For the reasons set forth above, however, the proposed modification of Weatherby and Lalonde fails to establish a prima facie case of obviousness. The rejection of claims 3, 11, and 19 should therefore be withdrawn, and the claims should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 3, 11, and 19.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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